

Application No.: 10/655,900

Docket No.: JCLA11392

**REMARKS****Allowable Subject Matter**

Applicants appreciate the allowance that Examiner made to claims 1-5 and 14-17. While allowed independent claims 1 and 14 remain unchanged, the allowance made thereto is also solicited to be remained.

**Present Status of the Application**

The Office Action allowed presently pending claims 1-5 and 14-17 and rejected presently-pending claims 6-13 and 18-21. Specifically, the Office Action rejected claims 6-13 and 18-21 under 35 U.S.C. 103(a), as being unpatentable over Charlier et al. (U.S. Patent No. 6,934,568) in view of Hayashi (U.S. Patent No. 6,650,913). Applicants have amended claims 3, 4, 6, 10-13 and 17-21 to more explicitly describe the claimed invention. After entry of the foregoing amendments, claims 1-21 remain pending in the present application, and reconsideration of claims 6-13 and 18-21 is respectfully requested.

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**Discussion of Office Action Rejections**

The Office Action rejected claims 6-13 and 18-21 under 35 U.S.C. 103(a), as being unpatentable over Charlier et al. (U.S. Patent No. 6,934,568) in view of Hayashi (U.S. Patent No. 6,650,913). Applicants respectfully traverse the rejections for at least the reasons set forth below.

Independent claim 6 recites the features as follows:

6. A handheld electronic device, comprising:

a base;

a cover;

a shiftable pivot structure slideably mounted in the base and pivotably connecting with the cover at a pivotal connection point.

(emphasis added).

Claims 7- 13 also recite the similar features.

In re U.S. Patent No. 6,934,568 (Column 2, line 45 ~ Column 3, line 15), Charlier et al. disclosed that " Referring to FIGS. 1 and 2, a communication device 10 such as a portable radiotelephone is shown which incorporates an extending hinged flip apparatus, in accordance with the present invention. The device 10 includes a base housing 16, an extendable housing

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14, and a flip housing 12, in a clamshell configuration. The device 10, and in particular, the base housing 16 contains electronic circuitry which allows communications over a radio frequency channel. The base housing 16 includes a front surface 18 wherein a user interface is disposed. The flip housing 12, commonly referred to with various names such as a clamshell, flip door, flip, or flap, is mechanically and rotatably coupled by a hinge assembly 22 to the base housing 16. The flip housing has a closed position (FIG. 1) being in proximity to the front surface 18 of the base housing 16 and an open position (FIG. 2) where the flip housing 12 extends away from the base housing 16. The flip housing 12 can rotate between the open position for a telephone operation, and the closed position for a two-way radio operation, for example. The extendable housing 14 is configured to slideably engage the base housing 16 and has an extended position (shown in FIG. 2) and a collapsed position (shown in FIG. 1). Two edges 36 of the base housing are circularly contoured to engage channels 38 in the extendable housing. The channels 38 include at least two circular sidewalls surrounding and retaining the base housing 16. It should be recognized that the base housing edges and extendable housing channels can be of any other suitable shape to slideably engage each other. Preferably, the extendable housing 14 covers a headset jack 46 on the base housing 16 when in the collapsed position. In this way, the headset jack 46 can only be accessed when the device 10 is open. This is particularly useful where an antenna of the device is deployed on one of the flip or extending housings, forcing the antenna to be deployed during a call".

As given above (mechanism shown in figures 1 and 2), Applicants find that the base housing 16 of the communication device 10 disclosed by Charlier et al. is slideably mounted in

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the extendable housing 14 and pivotably connecting with the flip housing 12. Obviously, Examiner deemed that the base housing 16 disclosed by Charlier et al. is corresponding to the shiftable pivot structure in claim 6 and the extendable housing 14 disclosed by Charlier et al. is corresponding to the base in claim 6. However, the flip housing 12 disclosed by Charlier et al. is corresponding to the cover recited in claim 6 and the base housing 16 disclosed by Charlier et al. is corresponding to the base recited in claim 6 from Applicants' viewpoint. In other words, Applicants submit that one ordinary skilled in the art would consider the base housing 16 disclosed by Charlier et al. as the base in claim 6 undoubtedly. Therefore, Applicants assert that the shiftable pivot structure that is slideably mounted in the base and pivotably connecting with the cover recited in claim 6 is not disclosed in U.S. Patent No. 6,934,568 and the rejection should be withdrawn.

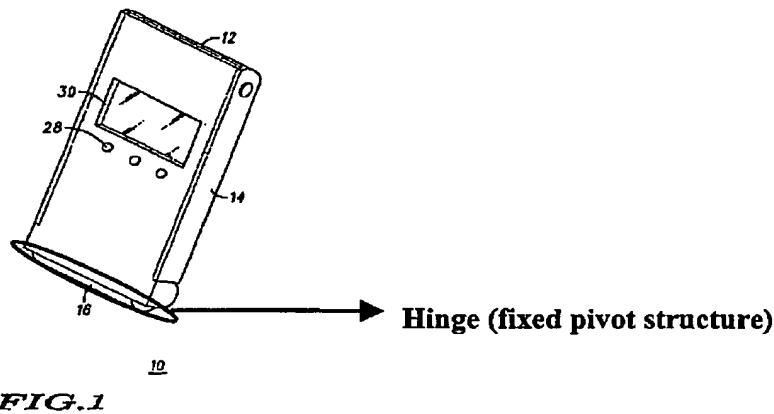
Please refer to figures 1 and 2 of U.S. Patent No. 6,934,568, Applicants find that the hinge (shown in the following drawing) pivotally connected between the flip housing 12 and the base housing 14 is similar to the hinge disclosed in applicants' admitted prior art (AAPA) of the present application. Applicants consider that the hinge (shown in the following drawing) pivotally connected between the flip housing 12 and the base housing 14 is an element with similar function as the shiftable pivot structure, but the hinge (shown in the following drawing) is a kind of fixed pivot structure and would be damaged easily. In addition, Applicants assert that Charlier et al. fail to teach or suggest the use of shiftable pivot structure.

In the disclosure (FIG. 2) of Hayashi, a mobile telephone unit 10 including a body part 101 and a cover part 102 is discussed. The mobile telephone unit 10 disclosed by Hayashi is also

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similar to applicants' admitted prior art (AAPA) of the present application. Additionally, there is no teaching or suggestion provided by Charlier et al. or Hayashi to substitute a fixed pivot structure with a shiftable pivot structure. The prior-art references do not contain any suggestion (express or implied) that they be combined, or that they be combined in the manner suggested. Therefore, Applicants submit that there is no motivation for an ordinary skill in the art to combine disclosures of Charlier et al. and Hayashi to make claims 6-13 obvious.

**FIG. 1**

With respect claims 7-9, Applicants submit that the feature "pivotal accommodation groove" recited therein is not disclosed by Charlier et al. and is non-obvious. Therefore, the rejection should be withdrawn.

With respect to claims 9-11, Applicants submit that the handheld electronic device in claims 9-11 would also be patentable over the communication device 10 shown in figures 1 and 2 because Charlier et al. fail to disclose that "the pivotal connection point between the shiftable pivot structure and the cover is movable between a first position in which the pivotal

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connection point is located inside the pivotal accommodation groove and a second position in which the pivotal connection point is located outside the pivotal accommodation groove". Specifically, the hinge (shown in the above drawing) pivotally connected to the base housing 16 is a kind of fixed pivot structure and the hinge is not covered by the flip housing 12 anytime. Therefore, Applicants assert that the hinge shown in the above drawing can "NOT" make the shiftable pivot structure recited in claims 9-11 obvious.

Independent claim 18 recites the features as follows:

18. A method of using a handheld wireless communication device which has a base and a cover, a shiftable pivot structure slideably mounted in the base between first and second positions and pivotably connecting with the cover at a pivotal connecting point, wherein when the shiftable pivot structure is at the first position, the pivotal connecting point is located in the base and when the shiftable pivot structure is at the second position, the pivotal connecting point is located outside the base, the method comprising:

(a) moving the shiftable pivot structure from the first position to the second position when then cover is closed to the base, such that the shiftable pivot structure is moved outside the base; and

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(b) pivoting the cover about the pivotal connecting point in a direction that the cover is away from the base to thereby open the cover to a position that the handheld wireless communication device can be operated.

(emphasis added).

Claims 19- 21 also recite the similar features.

With respect to claims 18-21, either Charlier et al. or Hayashi fail to teach or suggest that "a shiftable pivot structure slideably mounted in the base between first and second positions and pivotably connecting with the cover at a pivotal connecting point, wherein when the shiftable pivot structure is at the first position, the pivotal connecting point is located in the base and when the shiftable pivot structure is at the second position, the pivotal connecting point is located outside the base". Additionally, either Charlier et al. or Hayashi also fail to teach or suggest that "moving the shiftable pivot structure from the first position to the second position when then cover is closed to the base, such that the shiftable pivot structure is moved outside the base". Examiner fails to establish Prima Facie Cases of Obviousness. Therefore, Applicants submit that claims 18-21 are patentable over U.S. Patent No. 6,934,568 in view of U.S. Patent No. 6,650,913.

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In re Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1385 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention."), Applicants respectfully submits that claims 6-13 and 18-21 patently define over the prior art references and should be allowed because that there is no suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.

In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1998) ("When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention."), Applicants respectfully submits that claims 6-13 and 18-21 patently define over the prior art references and should be allowed because Charlier et al. and Hayashi fail to provide some suggestion, teaching, or motivation.

For at least the foregoing reasons, Applicant respectfully submits that independent claims 6 and 18 patently define over the prior art references, and should be allowed. For at least the same reasons, dependent claims 7-13 and 19-21 patently define over the prior art as well.

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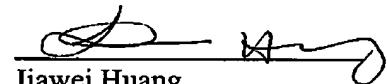
**CONCLUSION**

For at least the foregoing reasons, it is believed that the pending claims 1-21 are in proper condition for allowance. If Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, Examiner is invited to call the undersigned.

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